



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,348	12/15/1999	MILAN M. SHAH	13768.122	7423

7590 07/20/2004

RICK D. NYDEGGER  
WORKMAN, NYDEGGER & SEELEY  
1000 EAGLE GATE TOWER  
60 EAST SOUTH TEMPLE  
SALT LAKE CITY, UT 84111

EXAMINER

BURGESS, BARBARA N

ART UNIT	PAPER NUMBER
----------	--------------

2157

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/464,348

Applicant(s)

SHAH ET AL.

Examiner

Barbara N Burgess

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,9-12 and 33-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 9-12, 33-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2157

### DETAILED ACTION

This Office Action is a response to amendments filed April 21, 2004. Claims 1, 9-12, 33-44 are presented for further examination.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 9-12, and 33-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thurlow et al. (hereinafter "Thurlow", 5,917,489) in view of Gainey et al. (hereinafter "Gainey", US 2002/0099681 A1).

As per claims 1 and 12, Thurlow does not explicitly disclose:

- Assigning a user-defined priority to the user-created command relative to an assigned priority of the standard command, wherein the user-defined priority is assigned only after the user-created command is registered in one or more databases that store the standard command;
- Executing at least one of the standard command and the user-created command in order of assigned priority.

Art Unit: 2157

However, in an analogous art, Gainey discloses assigning priority to the rules used to manipulate the messages as well as executing the rules based on their individual priority (paragraphs [0033] – [0051]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate assigning priority to the commands in Thurlow's method making the rules effective in such a manner that no rule actions conflict with each other.

As per claims 9-11 and 43-45, Thurlow discloses:

- The standard command is stored in a first database (column 8, lines 41-46, column 10, lines 41-47, column 14, lines 50-54);
- The user-defined command is stored in a second database (column 8, lines 41-46, column 10, lines 41-47, column 14, lines 50-54);
- The first database and the second database are the same database (column 8, lines 41-46, column 10, lines 41-47, column 14, lines 50-54).

As per claims 33 and 38, Thurlow further discloses including an act of identifying the at least one of the standard command and the user-created command that is to be executed based upon a determination of whether the user-created command is registered in an event-binding database (column 10, lines 40-45, column 12, lines 57-67 column 17, lines 1-25).

Art Unit: 2157

As per claims 34 and 39, discloses including an act of registering the user-created command into an event-binding database and prior to executing the user-created command an act of determining that the user-created command is registered in the event-binding database (column 9-13).

As per claims 35-36, and 40-41, Thurlow does not explicitly disclose:

- The priority of the standard command is a neutral priority.
- The assigned priority of the user-created command is a priority other than a neutral priority.

However, in an analogous art, Gainey discloses assigning priority to the rules used to manipulate the messages as well as executing the rules based on their individual priority (paragraphs [0033] – [0051]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate assigning neutral priority to the commands as well as a priority other than neutral in Thurlow's method making the rules effective in such a manner that no rule actions conflict with each other.

As per claims 37 and 42, Thurlow does not explicitly disclose:

- An act of sorting at least the user-created command and the standard command in a database based upon their priority prior to executing the at least one of the standard command and the user-created command.

Art Unit: 2157

However, in an analogous art, Gainey discloses a rule list in which action priority is determined by the rule's order (paragraph [0043]-[0045]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate sorting the commands based on priority in Thurlow's method in order to determine the order of the rules and which rule(s) has the highest priority.

### ***Response to Arguments***

**The Office notes the following arguments:**

(a) Examiner fails to show or allege that Gainey discloses the assignment of a user-defined priority to a user-created command relative to an assigned priority of a standard command, and wherein the user-defined priority is assigned only after the user-created command is registered in one or more databases that store the standard command.

3. Applicant's argument filed has been fully considered but is not persuasive.

**In response to:**

(a) Gainey discloses the email receiver making sure that no routing rule actions conflict with each other. In order to avoid conflicts, priorities are placed on rule actions. Gainey does disclose priority being determined based on the rule's order in the rule list; however, some rules take priority over order. For example, an internal collaborate action takes precedence over all other actions. As well, drop action takes precedence

Art Unit: 2157

over all other actions except collaborate. Therefore, priority to a user-created command is relative to the priority of standard commands (paragraphs [0034-0051]). Gainey further teaches user-created commands and standard commands stored in a list in the category database. In order for a rule (user-created command) to be implemented, it must be stored in a category. Therefore, once it is stored, it then receives a priority, and then it can be implemented or executed by the email receiver (paragraphs [0052-0063, 0069]). So, Gainey also teaches the user-defined priority is assigned only after the user-created command is registered in one or more databases.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N Burgess whose telephone number is (703) 305-3366. The examiner can normally be reached on M-F (8:00am-4:00pm).

Art Unit: 2157


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Barbara N Burgess  
Examiner  
Art Unit 2157

\*\*\*

July 11, 2004



SALEH NAJJAR  
PRIMARY EXAMINER